

App. No. 10/827,468
Attorney Docket 3053.2.2np

Remarks

Applicant thanks the Examiner for the Written Office Action.

With regard to the substantive portion of the Written Office Action, Claims 27 – 34 were withdrawn; the drawings were objected to as not being labeled “Replacement Sheet” as required; Claims 1 and 22 were rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement; and Claims 1 – 5 and 21 – 26 were rejected under 35 USC 103(a) as being unpatentable over Price (US No. 6,691,471) in view of Eyring (US No. 6,219,982) and in the case of Claims 2 and 24 in further view of Trousilek (US No. 5,465,545).

Claims 1 and 22 are amended. Claims 27 – 34 are withdrawn. The Applicant responds below to each of the issues present in the Written Office Action:

Election

Claims 27 – 34 are withdrawn.

Drawings

The illustration of Figure 3 was provided to point out features shown in the drawings and to supplement the arguments; not as a replacement drawing. This was mentioned in the arguments themselves. Accordingly, as there are no new drawings, the Applicant respectfully requests withdrawal of the objection to the drawings.

35 USC 112

The Written Office Action states that the colorant being included in the matrix is not inherently disclosed because “the Applicant discloses that the material is painted, not colored which is a different way to provide color.” The Applicant respectfully notes the error of this statement. In particular, the original disclosure shows that the mold is

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painted, not the material. The material is disposed into the mold in a fluid state and cured within the mold. This process inherently causes the colorant that is painted inside the mold to migrate to a skin depth within the matrix of the material. At no point is the material ever painted. Accordingly, the Applicant believes that this misunderstanding is addressed and requests that the rejection under 35 USC 112, first paragraph be withdrawn.

35 USC 103(a)

Claims 1 and 22 are amended to include the limitation of "a colorant disposed in a surface skin of the three-dimensional rock pattern, the colorant incorporated as part of a matrix of the artificial cover." The PTO has the burden to establish a *prima facie* case of obviousness. (*In re Fine*, 837 F.2d, 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); MPEP '2142). "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." (MPEP §2143.03). The Applicant notes that none of the cited art include this limitation. In particular, the coloring in Eyring is created during an extrusion process which does not produce a colored skin, but instead produces a coloring throughout the entire matrix. Accordingly, the Applicant requests that the rejection of the present claims under 35 USC 103(a) be withdrawn.

Further, the Applicant submits that the limitation is inherent in the originally disclosed process. Accordingly, the Applicant believes that the limitation is not new matter.

Further, the Applicant submits that a combination of Price and Eyring under 35 USC 103(a) is inappropriate as hindsight. Applicant respectfully submits that claims 1

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and 22 (and claims dependent thereon), as previously presented, are patentable under 35 U.S.C. § 103(a) over Price in view of Eyring. In particular, Applicant believes that the reason given by the Examiner in the Written Office Action to combine the elements of Price and Eyring to make the claimed invention is impermissible hindsight. According to the Court's recent decision in *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, 14 (U.S. Apr. 30, 2007), in formulating a rejection under 35 U.S.C. § 103(a) there must be "an apparent reason to combine the known elements in the fashion claimed by the patent at issue." (*Id.*) In addition, "this analysis should be made explicit." (*Id.*)

However, it is well settled that hindsight is not a proper basis for rejecting the claims. *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.* 30 U.S.P.Q.2d 1377 (Fed. Cir. 1993). Furthermore, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). Therefore, a reason provided by an Examiner to combine elements of prior art to make the claimed invention cannot be based on impermissible hindsight.

In this instance, the basis is described as "to impregnate the plastic material in Price with the coloring as in Eyring because impregnating coloring lasts longer than a painted surface and is typically more aesthetically pleasing." There is no indication that one skilled in the art would appreciate or be aware of these isolated disclosures. Accordingly, the reason given by the Examiner for the combination is impermissible hindsight. As a result, the Examiner did not explicitly identify a reason as to why a person of ordinary skill in the art would have combined the prior art elements in the

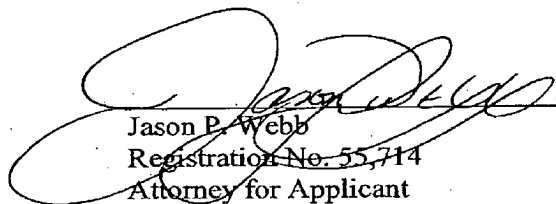
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manner claimed. Therefore, Applicant respectfully submits that the claims, as previously presented, are patentable under 35 U.S.C. § 103(a).

Conclusion

For these reasons, it is believed that none of the prior art teaches the claimed invention. Furthermore, it is believed that the foregoing amendment has adequate support in the specification, and accordingly there should be no new matter. Applicant believes the pending claims have addressed each of the issues pointed out by the Examiner in the Office Action. In light of the foregoing amendment, the claims should be in a condition for allowance. Should the Examiner wish to discuss any of the proposed changes, Applicant again invites the Examiner to do so by telephone conference.

Respectfully Submitted,



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